CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants point out that there is some confusion concerning the pending claims. The Office Action refers to claims 1-9, yet the Preliminary Amendment dated January 20, 2004, made some changes in claims 1-9, and added claims 10-15. In case that preliminary amendment is not of record, a copy is now attached. Since Applicants believe the preliminary amendment accompanied the application when filed, examination of claims 10-15 is respectfully requested.

Further amendments have been made to claim 1. A mark-up showing the changes that have been made to claim 1 using strikethrough and underlining appears above.

The specification was objected to because it lacked a brief description of the drawings. This has now been provided.

Claim 4 was rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. In response, Applicants believe the Examiner's concerns were already overcome with the amendments to claim 4 in the preliminary amendment.

Claims 1-9 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants again believe the Examiner's concerns were already overcome with the amendments to the claims in the preliminary amendment.

For the record, Applicants emphasize that although the claims were amended, and, therefore, might be argued to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are

entitled to the full range of equivalents.

Claims 1-9 were rejected under 35 USC § 103(a) as being obvious over Klueppel et al. ("Klueppel"), U.S. Patent No. 5,145,665. In response, Applicants submit that Klueppel does not make out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. Applicants component a) requires an alkyl glucoside of the particular formula recited. The Examiner has not explained where in Klueppel compounds having this formula are specifically taught, or, if generically taught, why a person skilled in the art would have been led by Klueppel to select alkyl glucosides of the formula recited in the claims.

Further, as Applicants understand the Examiner's rejection, Applicants components b) and c) both correspond to Klueppel's ***optional*** humectant component. The Examiner has not explained where in Klueppel there is any teaching or suggestion to select and combine these particular optional humectants, nor the motivation of a person skilled in the art to do so. Although the claimed invention may be within the generic teachings of the prior art, and could have been achieved with the proper selections, a *prima facie* case of obviousness is not made out unless the prior art highlighted these selections in some manner, and, therefore, led persons skilled in the art towards them. *See, In re Baird,* 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by

itself render that compound obvious.") Klueppel does not highlight mixtures of humectants, nor glycerol and Carbopol as being components of useful humectant mixtures. Consequently, a person having ordinary skill in the art would have been without adequate motivation to select glycerol and Carbopol from Klueppel's list of humectants, and then combine them to achieve Applicants' invention.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 1-7 were rejected under 35 USC § 103(a) as being obvious over Giret et al. ("Giret"), U.S. Patent No. 5,409,640. In response, Applicants submit that this rejection suffers from defects similar to those with the Klueppel rejection. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

According to the Examiner, the present invention would have been obvious "because the reference teaches that all of the components claimed by applicant are suitable for inclusion in a personal care composition." Referring, again, to the *Baird* decision, *supra,* Applicants submit that this clearly is insufficient. Even if the Examiner is correct that all of Applicant's ingredients were known, and even known in a single prior art reference, there still must be motivation to

select Applicants' particular ingredients and combine them in the manner Applicants claim. There is no such motivation here. Consequently, Giret does not make out a *prima facie* case of obviousness.

Applicants' claimed ingredients b) and c) are, again, only optional components in Giret's formulation. There is nothing to highlight them, or to suggest their combination into a specific formulation meeting the terms of Applicants' claims. The Examiner tries, for example, to highlight glycerol by saying the reference teaches "Glycerol is highly preferred." However, the reference actually teaches "glycerin is highly preferred." See, column 8, lines 49-50. In any case, glycerin or glycerol are only optional components. See, column 8, lines 32-33. There still is no reason given why persons skilled in the art should selected each of Applicants' claimed ingredients, some of which are described by Giret as being "optional," and combine them together to achieve Applicants' invention.

Respectfully, the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Finally, as to any issue of obviousness-type double-patenting, Applicants respectfully request that this be held in abeyance until allowable subject matter is indicated.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By

Kurt G. Briscoe
Reg. No. 33,141

875 Third Avenue
18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844

HEIKE LERG ET AL.
USSN 10/761,027
REPLY TO OFFICE ACTION DATED AUGUST 17, 2004
AMENDMENT OF FEBRUARY 17, 2005

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the accompanying copy of the Preliminary Amendment dated January 20, 2004, and Petition for Extension of Time (pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: February 17, 2005 By: Kurt G. Briscoe